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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,458	04/26/2001	Steven J. Tallarida	STD 00.02	8003

7590 12/23/2003

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EXAMINER

THANH, LOAN H

ART UNIT PAPER NUMBER

3763

DATE MAILED: 12/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,458

Applicant(s)

TALLARIDA ET AL.

Examiner

LoAn H. Thanh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

The drawing objections have been withdrawn in view of applicant's remarks on page 7-8 of the amendment filed 09/26/03.

The specification objection has been withdrawn in view of applicant's remarks filed 09/26/03.

In view of applicant's amendment the rejection under 35 U.S.C. 112, 2nd paragraph has been withdrawn. However, this amendment constitutes new matter. Since the units were never disclosed before, the lack of units give rise to the unclarity of any units or what units. Further, Shore A and shore D durometer scales are more common and preferred methods but there is a range of overlap which occurs. The Shore A and shore D are preferred method for rubber/elastomer and shore A for softer and shore D for harder rubbers. But that is not necessarily exclusive. Also, there are other durometer scales (shore B, C, O and H) which overlap even if they are not commonly or widely used they are known. Applicant is directed to look at durometer conversion tables.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The insertion of "Shore A" scale is considered to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is vague and indefinite because "said ports" lacks proper antecedent basis in line 2 of the claim. It appears that applicant may have inadvertently overlooked "said ports" in line 2. Correction is requested to overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3, 5-7 are rejected under 35 U.S.C. 102 (b) as being anticipated by Wadsworth, Jr. et al. (U.S. Patent No. 5,399,168).

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Wadsworth, Jr. et al. disclose a hemodialysis port having a housing defining a plurality of interconnected chambers, a septum 64 attached to the sidewall portions and a spring mechanism/ septum support 26. The spring mechanism of Wadsworth, Jr. et al. is disclosed for radial support and compression to the septum. See figs. 2, 7, 8. The titanium insert (32) is seen in Figs. 5-6.) The function of the spring mechanism as claimed is capable of being performed by Wadsworth, Jr. et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable Powers et al. (U.S. Patent No. 5,833,654) in view of Eliassen et al. (U.S. Patent No. 6,213,973).

Powers et al. teach all the limitations of the claims except for the durometer of the septum. Eliassen et al. teach an access port in the same field of endeavor. Eliassen et al. teach the septum having a material with a durometer of between 30 and 55. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the septum durometer as taught by Eliassen et al. in order to provide a septum which seals the target aperture and enables repeated selective access to the reservoir without compromising the septum.

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Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wadsworth, Jr. et al. (U.S. Patent No. 5,399,168) in view of Powers et al. (U.S. Patent No. 5,833,654).

Wadsworth, Jr. et al. disclose the invention as substantially claimed. Wadsworth, Jr. et al. disclose some of the materials used for the device are titanium and stainless steel. However, Wadsworth, Jr. et al. does not disclose a titanium insert. Powers et al. disclose a titanium insert in the analogous art of implantable ports. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wadsworth, Jr. et al. with a titanium insert as taught by Powers et al. in order to prevent puncturing and damaging the device .

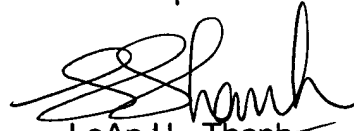
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038. The examiner can normally be reached on Monday to alternating Fridays (7:00 am-4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read 'LoAn H. Thanh', written in a cursive style.

LoAn H. Thanh
Examiner
Art Unit 3763

LT